



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/276,868 03/26/99 SIMONS

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HM12/0330

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EXAMINER

MOEZIE, F

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 03/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

file
Office Action Summary

Application No.
09/276,868

Applicant(s)
Simons

Examiner
F. T. Moezie

Group Art Unit
1653



☒ Responsive to communication(s) filed on 3/26/99 and 7/26/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

CLAIMS STATUS

Claims 1-14 are pending in this application.

OBJECTION - SPECIFICATION

The specification is found objectionable regarding the content of pages 12, Flow Scheme A; page 12, Table 3 and page 27, table 4. The first two pages have to be included and submitted as drawings. The content of table 4 appears to be out of context and does not belong within the pages of the specification. Applicant has already submitted SEQ ID NOS for the sequences in the specification and they have been approved by the Office.

CLAIMS REJECTION - 35 USC 112, FIRST AND SECOND PARAGRAPHS

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The terminology cited at parts a), b) and c) of claims 1 and 2, i.e., “~~8~~7

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subunit of the proteasomes”, “interacting α 7 subunit becomes selectively altered” and “ the selectively altered --- collection of viable cells”; the introduction means of claims 5 and 6, I. e., “receptor-specific peptide introduction means” and “the DNA sequences coding for PR-39 oligopeptides of different sizes inserted in a suitable vector for transection and subsequent expression of peptides within said cells” and in claims 9 and 10 “wherein degradation of ---.” have not been disclosed in the specification. Therefore, the specification is not fully descriptive in this regard.

Claims 11-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The use for the truncated PR-39 has not been shown. According to the US patent to Gallo et al the necessary number of amino acids in the peptide sequence and its modified form require the presence of all of the 39 amino acids for the peptide to show biological activity (col. 3, lines 26+). Therefore, use for truncated peptides would have to be evidenced.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-10 are indefinite as to how α 7, for example, becomes selectively altered. Additionally, in claims 9 and 10, the claims are indefinite as to how the degradation of I B or HIF-1 is selectively inhibited.

REJECTION - 35 USC 102 (b)/103 (a)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

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the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent No. 5,654,273 to Gallo et al.

The document discloses that a method for treating angiogenesis by using PR-39 is known in the art. See the entire document, especially abstract and examples. Because the claims are drawn to a method of using a known peptide for treating a condition taught by the art, regardless of the mechanism of action, the claims are inherently anticipated and/or rendered obvious by the art.

No claim is allowed.

Any inquiry concerning this communication should be directed to F.T. Moezie at telephone number (703) 305-4508 or Mr. LOW (SPE) at 308-2923.

F. T. Moezie
F. T. MOEZIE, Ph.D.
PRIMARY EXAMINER
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